

REMARKS

Claims 1 and 19-50 are pending in this application.

The Examiner has maintained the rejection of Claims 1, 23-37, 43 and 47 under the first paragraph of 35 U.S.C. §112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner maintains the reasons set forth in the previous Office Action (Paper Number 17):

Support for component A that comprises an aromatic-containing polyester is not apparent. The subgenus of aromatic-containing polyesters is not described in the specification as filed. The only species of aromatic-containing polyesters described for use in the invention are those synthesized from an aromatic polycarboxylic acid, an aliphatic polycarboxylic acid and an alcohol component. See the specification at page 9, line 26 through page 14, line 16 and examples. Since the application as filed contained neither a description of the subgenus aromatic-containing polyesters nor a description of species that in the aggregate amount to the same thing, it does not support a subgenus of aromatic-containing polyesters as component A. See *In re Welstead* 174 USPQ 449 (CCPA 1972).

As previously discussed in the Amendment filed February 21, 2003, the present case is clearly distinguishable from *Welstead*. In *Welstead*, the applicant was attempting to introduce into his claims a new subgenus where the specification contained neither a description of the subgenus nor descriptions of *any species thereof* which amount in the aggregate to the same thing. In fact, *Welstead* conceded that the specification contained no disclosure of compounds or examples of making the new subgenus. In contrast to *Welstead*, applicants submit that the application as filed does contain a description of species that in the aggregate amount to

the subgenus of aromatic-containing polyesters as presently recited in Claims 1, 30 and 35. For example, the specification on page 8, lines 25-29 states that "the polyesters suitable for use in the adhesive according to the invention may be any type of polyester which, on the strength of its properties, fulfills the above-mentioned specifications for use in component A and component B." The specification then sets forth on page 9, lines 9-11 that "component A contains a polyester which is synthesized from at least a first and a second acid component and at least a first alcohol component" and further on page 10, lines 24-26 where it is stated that component A or component B or component A and component B is/are synthesized from an aromatic acid component as a first acid component. Additionally, the specification sets forth on page 9, lines 26-28 that any aromatic polycarboxylic acids suitable for the synthesis of polyesters having the properties required for components A and B may be used as a first or second acid component and then further defines the aromatic polycarboxylic acids as those containing about 6 to about 24 carbon atoms with examples of such aromatic polycarboxylic acids (see page 10, lines 20-23). Finally, the specification provides working examples of how the aromatic-containing polyester subgenus is made. As such, and in contrast to the Examiner's allegations, one skilled in the art of chemistry would clearly recognize from a reading of the application that the resulting polyester formed from these components *in the aggregate amount to an aromatic-containing polyester*.

The Examiner further maintains in the present Office Action that "the sub-genus aromatic containing polyester encompasses polyesters other than polyesters prepared from a first aromatic acid, a second acid and an alcohol, such as polyester prepared from an aromatic alcohol and aliphatic acid". However, § 112 does not require mention of representative compounds encompassed by generic claim language and where no explicit description of a generic invention

is to be found in the specification mention of representative compounds may provide an implicit description upon which to base generic claim language. See, *In re Robbins*, 429 F.2d 452, 456-57, 166 USPQ 552, 555 (CCPA 1970), citing *In re Sus*, 49 CCPA 1301, 306 F.2d 494, 134 USPQ 301 (1962). As discussed above, the specification as filed provides ample disclosure of species and representative compounds thereof to provide an implicit description of the claimed aromatic-containing polyester having a number average molecular weight (M_n) of greater than 8000. Accordingly, contrary to the Examiner's assertions, such aromatic-containing polyesters having a molecular weight (M_n) of at least 8,000 of component A having a total enthalpy of fusion of at most 20 mJ/mg are fully described by the specification as to comply with the requirements for the first paragraph of 35 U.S.C. §112. Thus, withdrawal of the rejection of Claims 1, 23-37, 43 and 47 under the first paragraph of 35 U.S.C. §112 is respectfully requested.

The Examiner has rejected Claims 1 and 19-47 under 35 U.S.C. §103(a) as being obvious over Miller et al. U.S. Patent No. 5,552,495 ("Miller").

The Examiner maintains in the Office Action that while Miller does not exemplify an amorphous aromatic-containing polyester having a molecular weight (M_n) of at least 8,000 for use in the invention, in example 4 the amorphous aromatic-containing polyester has a molecular weight (M_n) of 7,300. Thus, it is the Examiner's apparent belief that since Miller teaches that the adhesives can have a molecular weight (M_n) of as high as 20,000 and a preferred molecular weight (M_n) as high as 10,000, it would have been obvious to select an amorphous aromatic containing polyester having a molecular weight (M_n) greater than 8,000 as this molecular weight is not significantly higher than the molecular weight of 7,300 as exemplified by the polyester of example 4 and use it in combination with lower molecular weight polyesters, such as the

polyesters exemplified in Miller, in order to obtain an adhesive having a higher molecular weight and improved tensile strength and peel strength. These wholly unsupported statements cannot possibly serve as a basis for this rejection. The Examiner is respectfully requested to provide reasons of particularity why an ordinary person skilled in the art would be motivated by the polyester of example 4 having a molecular weight (M_n) of 7,300 over the polyesters of examples 2 and 3 having a molecular weight (M_n) of 6,500 and 5,800, respectively, of Miller to form an adhesive composition having a melt viscosity of 500 to 25,000 mPas (Brookfield RVT DVII, 140°C, spindle 27) and a softening point of 70 to 100°C (ASTM E28) and comprising an amorphous aromatic-containing polyester having a number average molecular weight (M_n) of greater than 8000 and a polyester having a number average molecular weight (M_n) of less than 8000.

It is also well established that when obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *B.F. Goodrich Co. v. Aircraft Braking Systems Corp.* (CAFC), 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 citing *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). As is the case here, Miller nowhere provides any suggestion, motivation or even a hint of an adhesive composition comprising component A having a total enthalpy of fusion of at most 20 mJ/mg and component B having a glass transition temperature of at most 60°C in which (a) component A comprises at least one aromatic containing polyester with a molecular weight (M_n) of at least 8,000; and (b) component B comprises at least one polyester with a molecular weight (M_n) of less than 8,000, the adhesive having a melt viscosity of

500 to 25,000 mPas (Brookfield RVT DVII, 140°C, spindle 27) and a softening point of 70 to 100°C (ASTM E28) as present recited in Claims 1, 30 and 35.

Rather, Miller merely discloses sulfonate-containing, water-dispersible adhesive compositions having a number average molecular weight from about 2,000 to about 20,000 formed from either a single polyester, or a blend of polyesters. In point of fact, the examples of Miller either prepared single polyester adhesive compositions or adhesive compositions having a molecular weight (M_n) significantly less than 8,000 from a blend of polyesters, e.g., from a low of 1,563 for the resulting adhesive of example 4B to a high of 5,422 for the resulting adhesive of example 1B. Thus, there is simply no appreciation in Miller of combining an aromatic-containing polyester having a molecular weight (M_n) of at least 8,000 with a polyester having a M_n of less than 8,000 to form an adhesive composition. Accordingly, nothing in Miller would motivate one skilled in the art to modify the disclosure of Miller and arrive at the presently claimed adhesive composition as there is nothing in Miller to provide any suggestion or motivation to form a polyester blend from an aromatic containing polyester having a molecular weight (M_n) of greater than 8000 with a polyester having a molecular weight (M_n) of less than 8000. Absent such suggestion or motivation to modify the reference, Claims 1 and 19-50 are believed to be patentable over Miller and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner further alleges in the Office Action that with respect to Claims 48-50, it is unclear how the sulfonomers of Miller would materially affect the novel and basic characteristics of applicants' invention as defined in the balance of the claim, citing *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963).

All of the adhesives disclosed in Miller are *sulfonate-containing, water-dispersible* adhesive compositions having a number average molecular weight from about 2,000 to about 20,000 formed from either a single polyester, or a blend of polyesters. When forming the blend of polyesters, Miller requires that one of components of each of the polyesters be formed from a dicarboxylic acid containing a metal sulfonate group which indicates that the ester will build an *anionic* polymer dispersion in water. In contrast thereto, the presently claimed adhesives do not have this anionic character (salt form) thereby supporting the water-dispersability significantly as the adhesives are hydrophilic. Additionally, by employing polyesters not having a salt form, excellent biodegradability results are unexpectedly achieved (page 24, line 28 to 30) when using the resulting adhesive in such applications as, for example, medical articles such as bandages and sanitary articles such as diapers. Thus, the addition of a sulfomonomer to the specifically recited components of the polyesters presently set forth in Claims 48-50 would affect its utility as an adhesive. Accordingly, Claims 48-50 are believed to be further patentable over Miller.

For the foregoing reasons, amended Claims 1 and 19-50 are believed to be nonobvious, and therefore patentable, over Miller. Thus, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing, Claims 1 and 19-50 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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